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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,718	05/14/2001	Radislav Alexandrovich Potyrailo	RD-28,013	8673

7590 12/03/2003

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EXAMINER
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VANORE, DAVID A

ART UNIT	PAPER NUMBER
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2881

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/854,718

Applicant(s)

POTYRAILO ET AL.

Examiner

David A Vanore

Art Unit

2881

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20, 22-32 and 46-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20, 22-32 and 46-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

***Response to Arguments***

Applicant's arguments filed September 19, 2003 have been fully considered but they are not persuasive.

Applicant argues that Nielsen does not teach or suggest a testing device, a combinatorial array having test result samples, and a radiation source and detector.

Examples 1-3 on Col. 11-12 indicated that samples have a plurality of tests applied thereto to change physical or chemical properties. The samples are combined onto arrays, illuminated with the optical system wherein the fluorescent intensity from each library element is observed as a function of temperature. Clearly Nielsen teaches that tests are applied to the array of coated substrates (Example 3 in light of the definition of Substrate and Layer in Nielsen). Further, Nielsen teaches that testing conditions are varied across the substrate as in Col. 13 where each row of the array receives a different compound quantity in transition temperature test.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-20 and 22-32 stand rejected; while claims 46-59 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Nielsen.

Nielsen teaches a device and method for optical analysis of a combinatorial array comprising the following in regards to claims 1-4, 7-9, 11-12, 15-20, 22-28, 31-32, 46, 47, 48, 51, 52, 53, 55, and 56:

1) A combinatorial array having a surface with a plurality of predefined regions (Col. 6 Line 44-Col. 7 Line 14) comprising a plurality of sample or reference regions measured simultaneously (Col. 10 Lines 64-68), where the regions may be concave or convex (dimpled or beaded), the array may comprise a substrate with a deposited coating (Col. 7 Lines 33-43) where the substrate may be comprised of glass, silicon, metals, ceramics (Col. 7 Line 64) and the coating may be transparent, opaque, organic, or inorganic (Col. 7 Lines 45-50). Nielsen further teaches the varying of test conditions across a sample array to test a variety of physical conditions including temperature exposure testing (Col. 12 Example 3). Since a physical test is being performed on the array of samples, Nielsen includes testing means such as an optical system (Col. 10) for measuring various physical properties of the array elements.

2) A radiation source for exposing the array to incident radiation of between  $10^{-14}$  meters and  $10^4$  meters. (Col. 7 Lines 15-20).

3) A detector in the form of a CCD for collecting the radiation reflected from the array (Col. 11 Lines 30-40) where spatial filters compensate for the curvature or structures affecting the focus of the excitation radiation and an optical train filters selected incident radiation (Col. 11 Line 8-15).

4) A means for applying a test to each region of the array, in the instant case, Nielsen teaches a means for controlling the temperature of the environment (See Example 1 on Col. 11)

5) A computer to control the system and determine the performance of each test region (Col. 5 Lines 22-45).

Regarding claims 13-14, 29-30, and 57-59, Nielsen also teaches the use of a luminescent dye compound in each of the predefined regions (See General Overview starting on Column 7 Line 44).

Regarding claims 10 and 54, Nielsen teaches that the substrate may be a flat polymer thin film and defines a substrate any material having a rigid or semi-rigid surface (Col. 6 Lines 44-60 and Col. 7 Lines 45-65).

Regarding claims, 5-6, 26-27, 49-50, Nielsen teaches that the substrate or coating disclosed does not interfere, or inherently luminesce, during the analysis process. This teaching by Nielsen (Col. 6 Lines 9-17), while away from the embodiment claimed by the applicant, is valid under 35 USC 102(a) because it is still a teaching of the claimed subject matter.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

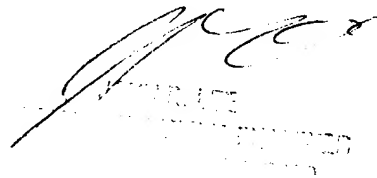
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A Vanore whose telephone number is 703-306-0246. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Lee can be reached on 703-308-4116. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

dav



DAVID A. VANORE  
EXAMINER